

REMARKS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the following remarks. Claims 7-12 remain pending, of which claims 7 and 10 are independent.

INTERVIEW CONDUCTED

Applicant thanks the Examiner for conducting an interview with Applicant's representative on February 16, 2005.

§ 112, 1ST PARAGRAPH REJECTION

Claims 7 and 10 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the Applicant had possession of the claimed invention at the time the application was filed.

As agreed during the interview, independent claims 7 and 10 have been amended to recite "wherein the file name includes numerical characters" to overcome the Section 112, first paragraph rejection.

Applicant respectfully request that the rejection of claims 7 and 10 be withdrawn.

§ 103 REJECTION – FUKADA

Claims 7-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fukada et al. (EP 0 838 767 A2, hereinafter “Fukada”). Applicant respectfully traverses this rejection.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. See *M.P.E.P. 2142*. One requirement to establish a *prima facie* case of obviousness is that the prior art reference must teach or suggest all claim limitations. See *M.P.E.P. 2142*; *M.P.E.P. 706.02(j)*. Thus, if the cited reference fails to teach or suggest one or more claimed elements, then the rejection must fail.

In the previous Reply filed on August 6, 2004, Applicant argued that Fukada cannot be relied upon to teach or suggest the feature of “an image-file recording controller for changing a file name of the image file that has been read out of the first loadable and removable recording medium to the incremented file-number generated by said incrementing device and recording the read image file on the second loadable and removable recording medium without checking for duplicate file names in the second loadable and removable recording medium” as recited in independent claim 7 and similarly in independent claim 10. *Emphasis added*. Applicant maintains this argument.

In the Response to Arguments section of the Final Office Action, the Examiner stated "Fukada process could be modified by bypassing the step of checking for duplication." *See Final Office Action, page 4.* Applicant respectfully notes that "could" is not the proper standard for establishing a *prima facie* case of obviousness. Fukada must teach or suggest the feature, but the Examiner has not yet provided such reasoning.

Applicant demonstrated in the August 4, 2004 Reply that Fukada explicitly teaches away from this recited feature. Namely, Fukada teaches always checking to determine if the file names overlap. Indeed, the Examiner admitted to this as much. The Examiner stated "... check for duplication file name must always be made as taught by Fukada." *Emphasis added; see Final Office Action, page 4.*

Clearly, because a check for duplication file names **must always** be made, Fukada is in complete contrast to the invention as claimed in the present application. Therefore, independent claims 7 and 10 are distinguishable over Fukada.

Claims 8, 9, 11 and 12 depend directly or indirectly from independent claims 7 and 10. Therefore, these dependent claims are distinguishable over Fukada for at least the reasons stated with respect to independent claims 7 and 10 as well as on their own merits.

Applicant respectfully requests that the rejection of claims 7-12 based on Fukada be withdrawn.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By: 

D. Richard Anderson
Reg. No. 40,439

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DRA/HNS

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000